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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,447	10/17/2003	Cory O. Nykoluk	10759-00160	1563

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EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3781

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/688,447

Applicant(s)

NYKOLUK ET AL.

Examiner

Tri M. Mai

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 30-52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 3781

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tangent point in claims 36 and 51 along with the handle being co-linear to the center axis in claim 37, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Claim 52 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent No. 6651791. Claims 1-16 teaches a wheeled baggage, a telescoping arm means and towing handle, and a passageway. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 9 of U.S. Patent No. set forth all the claimed structures of claim 52. It would have

Art Unit: 3781

been obvious to one of ordinary skill in the art to eliminate other limitations in claims 1 and 9 when they are not necessary.

3. Claims 30-41, 43-45, and 47-51 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6651791 in view of either Bieber (5645146) or King et al. (4759431). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of U.S. Patent No. 6651791 set forth a baggage, a handle having a hand grip with the pivot axis as claimed. It would have been obvious to one of ordinary skill in the art to provide the handle flush with the baggage as taught by Bieber or King to keep the handle from protruding

Regarding claim 39, note the T-shape handle in claim 8 inherently has a stem.

4. Claims 39-41 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims 1-16 of U.S. Patent No. 6651791, as set forth in paragraph 2, and further in view of Liang '080. To the degree it is argued that 6651791 does not teach a stem. It would have been obvious to one of ordinary skill in the art to provide a stem as taught by Liang to provide the desired shape of the handle.

5. Claims 36, 37, 39-46, and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 36, and 37, the original does not teach the pivot axis being tangent to the center axis of the arm portion and being co-linear to the distal end of the arm portion. See the 2nd paragraph rejection below. This is a new matter rejection.

Regarding claims 39-42, and 43-46 the original does not teach the handle comprises "at least one stem". This is a new matter rejection, see 112, 2nd paragraph rejection.

Regarding claim 42, the original does not teach the handle comprises two stems.

6. Claims 30-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 30 and 48, the claims recite the handle being connected to the distal end in a pivoting manner without set forth the structure necessary to enable such functionality.

Claims 36 and 37 are confusing. Claim 36 recites the arm portion being tangent to the center-axis. Then claim 37 recites the arm portion being co-linear to the center-axis. This is confusing because the embodiment only discloses one type of handle. It is either the arm portion being tangent to the center-axis or the arm portion being co-linear to the center-axis. Applicant is to explain how this is possible.

Claim 39 recites "at least one stem" referring that the handle can be function with two stems. However, the disclosure only shows the functionality with only one stem.

7. Claims 30, 31, 34, 35, and 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadow in view of Liang (5464080). Sadow meets all claimed limitations except for arm portion having adjustable axial length and a handgrip can pivot relative to the distal end. Liang teaches that it is known in the art to provide an arm portion having adjustable

Art Unit: 3781

axial length and a handgrip can pivot relative to the distal end as taught by Liang to provide and alternative handle to enable one to provide the desired length for the handle and to provide an alternative handle for the luggage.

8. Claims 32, 33, 48, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadow rejection as set forth in paragraph 6, and further in view of Browning. It would have been obvious to one of ordinary skill in the art to provide a non-circular cross section as taught by Browning, see figure 15 to provide the desired cross section for the handle.

9. Claims 30, 31, 34, 35, 37, 42-47, and 52 are rejected under 35 U.S.C. 102 (b) as being anticipated by Williams et al. (4538709). Williams teaches a baggage having a set of wheel a receptacle, retractable arms a towing handle having a handle grip 20 in such a manner that the handgrip can pivot relative to the distal end.

Regarding claim 31, note that the arm portion has curvature such that the arm portion curve along the length, i.e., the entire arm portion is curved with respect to the cross section being rounded.

Note that the handle can be position at a flushed position with the wall having the zipper 44 in in Fig. 2.

Regarding claim 52, note that portion 50a is the stem portion of the handle and there is a passage as shown in Fig. 9.

10. Claims 30-35, and 37-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen (6434790) in view of Bieber. Chen teaches a baggage with rotatable handle as claimed. With respect to the handle grip being partially retracted into the receptacle, it would have been

Art Unit: 3781

obvious to one of ordinary skill in the art to provide a recess at the top as taught by Bieber to enable to store the handle when not in use.

It would have been obvious to one of ordinary skill in the art to provide the handle flush with the baggage as taught by Bieber or King to keep the handle from protruding.

11. Claims 36, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Mao. It would have been obvious to one of ordinary skill in the art to provide the pivot axis being tangent to the center axis to enable one to carry on the shoulder comfortably.

12. Applicant's arguments filed have been fully considered but they are not persuasive.

With respect to the drawing objections, applicant asserts that axis B-B would meets the curved axis of the arm. It is noted that the claim recites "the pivot axis being tangent to the center-axis of the arm portion at the distal end of the arm portion" similar relationship with respect to the pivot axis being co-linear. This specificity of the relationship are not shown or described at all in the drawings as well as in the specification. Thus the objections stand.

With respect to the 112, 1st paragraph rejection, as set forth above, the specificity of the relationship "the pivot axis being tangent to the center-axis of the arm portion at the distal end of the arm portion" or "the pivot axis being co-linear to the center-axis of the arm portion at the distal end of the arm portion" is neither shown or described at all in the specification. Thus the new matter rejection stands.

With respect to the "at least one stem", this recitation implies that there can be more than one stem. This is different with the original specification showing only stem and the corresponding embodiment. Thus, the new matter rejection stands. Similarly, the 112, 2nd paragraph rejections stand.

Art Unit: 3781

Applicant asserts certain teaching in the specification. However, the examiner cannot locate such teaching showing that the handle can be constructed with more than one stem.

With respect to the double patenting rejection, applicant asserts that the claims must be considered in their entirety and differences in the claims may not be ignored. The amended claims do not overcome the double patenting rejection, the difference between the claims of 6,651,791 and the pending claims are limitations directed to the unobtrusiveness of the handle in the retracted position. This limitation is not deemed patentable in view of either Bieber or King as set forth above.

With respect to the rejection of Sadow in view of Liang, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to provide a plurality of sections along with the rotatable T-shaped handle would have been obvious..

With respect to the Williams reference, applicant asserts that the handle is not pivotable with respect to the uppermost pole section, the examiner submits that Williams shows the handle can pivot as shown in Figs 5 and 8. It is noted that portion 50a is the stem portion of the handle connected to the retractable arm (portions 50b, 50C), with the joint structure between the stem and arm portions 50b to be similar with other connections between portions of the arms, the

Art Unit: 3781

examiner submits that this stem portion 50a inherently can rotate relative to the distal end of the arm 50b as claimed.

With respect to the Chen reference, applicant asserts that the Chen reference is disqualify as a prior art in the parent patent, applicant to resubmit the declaration in this instant application for consideration. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571)272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3781

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tri M. Mai
Primary Examiner
Art Unit 3781

T.M. Mai